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In re Application of
PILU, Maurizio *et al*
Application No.: 09/786,825
PCT No.: PCT/GB00/02621
Int. Filing Date: 07 July 2000
Priority Date: 09 July 1999
Attorney's Docket No.: 30980088US
For: DOCUMENT IMAGING SYSTEM

DECISION ON
REQUEST TO WITHDRAW
HOLDING OF ABANDONMENT
AND 37 CFR 1.182

This decision is in response to applicants' "Petition Regarding Deposit Account Authorization Under 37 C.F.R. § 1.182" ("Pet.") filed on 15 August 2001 and "Response to Notification of Abandonment" ("Resp.") filed 17 September 2001. The \$130.00 petition fee has been paid.

BACKGROUND

On 07 July 2000, applicants filed international application PCT/GB00/02621 claiming priority to a British patent application filed 09 July 1999. A Demand for the international preliminary examination was not filed. Accordingly, the twenty-month period for paying the basic national fee in the United States expired at midnight on 09 March 2001.

On 09 March 2001, applicants filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 which was accompanied by, *inter alia*, authorization to charge the basic national fee to Deposit Account No. 08-2025.

On 15 August 2001, applicants submitted the instant petition along with, *inter alia*, a check of \$860.00 for the basic national fee; a check of \$130.00 for the petition fee; and an "Affidavit of Authority to Charge Deposit Account" signed by Jeffery B. Fromm of Hewlett-Packard Company.

On 11 September 2001, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909) stating that the above-captioned application was abandoned because applicants failed to provide the full U.S. basic national fee by twenty months from the earliest claimed priority date.

On 17 September 2001, applicant submitted a Response to the Notification of Abandonment which was accompanied by various documents.

DISCUSSION

Applicants claim that "[a]t the time of filing, the undersigned intended to charge Deposit Account No. 08-2025." Pet. ¶ 1. Counsel states that "[o]ver eighty (80) previous U.S. Applications of Hewlett-Packard were charged by me to their Deposit Account No. 08-2025, going back to August of 2000. In this instance, the only difference was that the letterhead for the Transmittal Letter did not contain the official Hewlett-Packard logo, a requirement not known to the undersigned at the time of filing." Id. at ¶ 3. Applicants included a letter from Hewlett-Packard authorizing counsel to charge official fees to Deposit Account No. 08-2025 with the instant petition.

A check with the Receipts Accounting Division of the Office of Finance at the USPTO revealed that neither Mr. John W. Ryan, or the law firm Wilmer, Cutler & Pickering was authorized to charge any fees to Hewlett-Packard's Deposit Account No. 08-2025 on 09 March 2001. The Hewlett-Packard Company's Deposit Account may be charged the basic national fee provided that the transmittal letter states that the attorney is working on behalf of Hewlett-Packard. However, a review of the transmittal letter did not indicate that counsel had any affiliation with Hewlett-Packard. Accordingly, it was appropriate for the Office of Finance not to charge the required fees from Deposit Account No. 08-2025 since applicants had no apparent authorization.

Moreover, 37 CFR 1.494(b)(2) states that "[t]o avoid abandonment of the application, the applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of 20 months from the priority date: (2) The basic national fee. The 20-month time limit may not be extended."

In this case, the 20-month time period expired on 09 March 2001 after claiming priority back to 09 July 1999. The basic national fee was not paid on 09 March 2001. A petition under 37 CFR 1.182 to alter the transmittal letter is not appropriate. Similarly, the Notification of Abandonment mailed 11 September 2001 was proper.

Furthermore, in the "Response to Notification of Abandonment" filed 17 September 2001, counsel claims that "[t]he undersigned has filed two other National Phase Utility Patent Applications in the Receiving Office . . . , with the full U.S. Basic National Fee being charged to Deposit Account No. 08-2025. Resp. ¶ 3. Applicants included a copy of a Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 (Form PCT/DO/EO/903) for U.S. application Nos. 09/786,768 and 09/869,421 with the response as exhibits.

A review of 09/869,421 reveals that the fees were properly charged in that application despite the fact that the transmittal letter did not show that the patent application was for the Hewlett-Packard Company. The declaration filed with the national stage papers listed the Hewlett-Packard Company, but the same information was not provided on the declaration in the above-identified application.

DECISION

Accordingly, applicants' petition under 37 CFR 1.182, and the petition to withdraw the holding of abandonment are both **DISMISSED** without prejudice.

The above-captioned remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Applicants could also file a petition to revive the above-captioned application pursuant to 37 CFR 1.137(a) or 1.137(b).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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